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AUG 18 2010

OFFICE OF PETITIONS

In re Application of :
Boivin et al. :
Application No. 10/507,067 : LETTER REGARDING
Filed: November 10, 2004 : PATENT TERM ADJUSTMENT
Docket No. EISN-018US :
Title: MACROCYCLIC COMPOUNDS USEFUL :
AS PHARMACEUTICALS :
:

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)," filed July 15, 2010.

Applicants request that the determination of patent term adjustment be increased by nine hundred and seventy-four (974) days to one thousand, two hundred and sixty-five (1265) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction partly on the basis that the Office will take in excess of three years to issue this patent. In addition, Applicants contend that one period of Office delay was incorrectly assigned and one period of applicant delay was incorrectly omitted.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of

issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, Applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that Applicants otherwise request reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the request is GRANTED.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Applicants dispute the adjustment of 51 days, pursuant to 37 CFR 1.703(a)(3) for Office delay in mailing a notice of allowance in response to the submission of a reply in compliance with 37 C.F.R. § 1.113(c): a first after-final amendment was filed on October 23, 2009, an advisory action was mailed on November 6, 2009, a second after-final amendment was filed on November 13, 2009, a third after-final amendment was filed on February 17, 2010, and a notice of allowance was mailed on April 15, 2010.

Applicants maintain that the Office incorrectly calculated the 4-month period for response as commencing on the 4-month anniversary of the October 23, 2009 amendment, instead of the 4-month anniversary of the February 17, 2010 amendment (which was in compliance with 37 C.F.R. § 1.113(c)).

Applicants further dispute the failure to accord a reduction of 118 days, pursuant to 37 CFR 1.704(c)(7) for applicant delay in filing a reply which contains an omission: a non-final Office action was mailed on August 16, 2007, a reply was submitted on February 19, 2008, a notice of non-compliant amendment was mailed on May 14, 2008, and a reply correcting the omission was provided on June 16, 2008, 118 days after the submission of February 19, 2008.

Applicants maintain that 118 days of applicant delay should have been accorded.

Applicants state that any patent issuing from the application is not subject to a terminal disclaimer.²

The application history has been reviewed and it has been determined that Applicants are correct on both counts.

With regard to the adjustment of 51 days, the Office agrees that it was improper to have calculated the 4-month period for response required by 37 CFR 1.703(a)(3) as commencing with the 4-month anniversary of the October 23, 2009 after-final amendment: the Office should have calculated the period for response as commencing with the 4-month anniversary of the February 17, 2010 amendment. As such, the notice of allowance was timely mailed, and no adjustment should have been made.

The adjustment of 51 days has been removed.

² Petition, page 5.

With regard to the submission of a reply which contains an omission, the Office agrees that a 118-day reduction should have been accorded.

A reduction of 118 days has been entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is one hundred and twenty-two (122) days (476 days of Office delay minus 354 days of Applicant delay).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office thanks Applicants for their good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to Applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of updated PAIR screen

PALM INTRANET

Day : Tuesday
Date: 8/17/2010

Time: 15:22:37

PTA Calculations for Application: 10/507067

Application Filing Date:	11/10/2004	PTO Delay (PTO):	527
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	236
Post-Issue Petitions:	0	Total PTA (days):	122
PTO Delay Adjustment:	-169		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
91	08/17/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		102	
90	08/17/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		118	
89	08/17/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	51		
80	04/15/2010	MAIL NOTICE OF ALLOWANCE	51		57
79	04/12/2010	ISSUE REVISION COMPLETED			
78	04/12/2010	DOCUMENT VERIFICATION			
77	04/12/2010	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
76	04/12/2010	CASE DOCKETED TO EXAMINER IN GAU			
75	04/08/2010	EXAMINER'S AMENDMENT COMMUNICATION			
74	04/08/2010	NOTICE OF ALLOWABILITY			
70	10/23/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
69	10/23/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
68	03/31/2010	DATE FORWARDED TO EXAMINER			
67	02/17/2010	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
64	12/18/2009	NOTICE OF APPEAL FILED			
63	12/18/2009	REQUEST FOR EXTENSION OF TIME - GRANTED			
62	11/20/2009	DATE FORWARDED TO EXAMINER			
61	11/13/2009	SUPPLEMENTAL RESPONSE		21	57
60	11/06/2009	MAIL ADVISORY ACTION (PTOL - 303)			
59	11/05/2009	ADVISORY ACTION (PTOL-303)			
58	10/27/2009	DATE FORWARDED TO EXAMINER			
57	10/23/2009	AMENDMENT AFTER FINAL REJECTION		30	51

56	10/23/2009	REQUEST FOR EXTENSION OF TIME - GRANTED		
55	10/23/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
54	10/23/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
53	10/23/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
52	10/23/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
51	06/23/2009	MAIL FINAL REJECTION (PTOL - 326)		
50	06/18/2009	FINAL REJECTION		
49	03/10/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED		
48	03/10/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED	0	46
47	04/08/2009	DATE FORWARDED TO EXAMINER		
46	03/10/2009	RESPONSE AFTER NON-FINAL ACTION	90	43
45	03/10/2009	REQUEST FOR EXTENSION OF TIME - GRANTED		
44	03/10/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		
43	09/10/2008	MAIL NON-FINAL REJECTION		
42	09/09/2008	NON-FINAL REJECTION		
41	07/02/2008	DATE FORWARDED TO EXAMINER		
40	06/16/2008	RESPONSE AFTER NON-FINAL ACTION		
39	05/14/2008	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT		
38	05/12/2008	MISCELLANEOUS ACTION WITH SSP		
37	02/26/2008	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)		
36	02/26/2008	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)		
35	02/26/2008	MISCELLANEOUS INCOMING LETTER		
34	03/10/2008	DATE FORWARDED TO EXAMINER		
33	02/19/2008	RESPONSE AFTER NON-FINAL ACTION	95	30
32	02/19/2008	REQUEST FOR EXTENSION OF TIME - GRANTED		
31	02/08/2008	CORRESPONDENCE ADDRESS CHANGE		
30	08/16/2007	MAIL NON-FINAL REJECTION		
29	08/03/2007	NON-FINAL REJECTION		

28	11/10/2004	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
27	05/25/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
26	06/04/2007	DATE FORWARDED TO EXAMINER			
25	06/01/2007	RESPONSE TO ELECTION / RESTRICTION FILED			
24	05/08/2007	MISCELLANEOUS INCOMING LETTER			
23	05/01/2007	MAIL RESTRICTION REQUIREMENT	476		9
22	04/30/2007	REQUIREMENT FOR RESTRICTION / ELECTION			
21	03/12/2007	CASE DOCKETED TO EXAMINER IN GAU			
20.7	05/25/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
20	05/25/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
19	03/27/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
18	11/10/2004	REFERENCE CAPTURE ON IDS			
17.7	11/10/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
17	11/10/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	03/27/2006	CASE DOCKETED TO EXAMINER IN GAU			
14	03/23/2006	CLEARED BY OIPE CSR			
13	03/23/2006	CLEARED BY OIPE CSR			
12	03/23/2006	CLEARED BY OIPE CSR			
11	03/23/2006	CLEARED BY OIPE CSR			
10	03/03/2006	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
9	11/10/2004	371 COMPLETION DATE			
8	03/13/2006	APPLICATION DISPATCHED FROM OIPE			
7	03/13/2006	NOTICE OF DO/EO ACCEPTANCE MAILED			
6	02/21/2006	ADDITIONAL APPLICATION FILING FEES			
5	02/06/2006	PRE-EXAM OFFICE ACTION WITHDRAWN			
4	02/06/2006	NOTICE OF DO/EO MISSING REQUIREMENTS MAILED			
3	01/31/2006	PCT CLASSIFICATION			
2	10/06/2005	CORRESPONDENCE ADDRESS CHANGE			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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